

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Robert Henri-Marcel Stouffs et al.
Patent No. : 7,935,190
Issue Date : May 3, 2011
Serial No. : 10/564,652
Filed : January 13, 2006
Title : PROCESS FOR PREPARING MALTITOL ENRICHED PRODUCTS

Art Unit : 1793
Examiner : David M. Brunsman
Conf. No. : 1660

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentees hereby request reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 1,179 days to 1,306 days is respectfully requested.

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (USPTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt USPTO response. “B Delays” are defined as delays by the USPTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. Patentees respectfully submit that the USPTO did not apply the proper standard for determining the period of “B Delay” under 35 U.S.C. § 154(b)(1)(B).

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

Applicant Delay

A reply to an Office Action was due on or before January 1, 2010 (the date that is three months after October 1, 2009, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on January 4, 2010, thereby according an Applicant Delay of 3 days. Patentees do not dispute the USPTO’s calculation for this Applicant Delay from January 2, 2010 (the day after the date that is three months after the date on which the Office Action was mailed), to January 4, 2010. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before July 14, 2010 (the date that is three months after April 14, 2010, the date on which the Office Action was mailed). Patentees filed a

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: July 1, 2011.

response to the Office Action on July 26, 2010, thereby according an Applicant Delay of 12 days. Patentees do not dispute the USPTO's calculation for this Applicant Delay from July 15, 2010 (the day after the date that is three months after the date on which the Office Action was mailed), to July 26, 2010. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before November 12, 2010 (the date that is three months after August 12, 2010, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on December 13, 2010, thereby according an Applicant Delay of 31 days. Patentees do not dispute the USPTO's calculation for this Applicant Delay from November 13, 2010 (the day after the date that is three months after the date on which the Office Action was mailed), to December 13, 2010. See 37 C.F.R. § 1.704(b).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 46 days (i.e., the sum of 3 days, 12 days, and 31 days).

USPTO "A Delay"

A first USPTO action was due on or before March 18, 2007 (the date that is fourteen months after January 13, 2006, the date on which the application was filed). The USPTO mailed the first non-final Office Action on October 1, 2009, thereby according a PTO Delay of 928 days. Patentees do not dispute the USPTO's calculation for this "A Delay" from March 19, 2007 (the day after the date that is fourteen months after the date on which the application was filed), to October 1, 2009. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

In view of the period of "A Delay" detailed above, the total "A Delay" for this patent should be calculated as 928 days.

USPTO "B Delay"

There is no dispute that the USPTO failed to issue a patent within three years of the filing date of the application and that Patentees are entitled to "B Delay" to compensate for that USPTO delay. The only issue in contention is the correct length of the "B Delay" period.

The period beginning on January 19, 2009 (the day after the date that is three years after the date on which the application was filed), and ending May 3, 2011 (the date the patent was issued), is 835 days in length. The "PTA 36 Months" entry in the PAIR/PALM system indicates

Applicant : Robert Henri-Marcel Stouffs et al.
Patent No. : 7,935,190
Issued : May 3, 2011
Serial No. : 10/564,652
Filed : January 13, 2006
Page : 3 of 4

Attorney's Docket No.: 19790-0005US1 / CER03-0006

that a total of 553 days were awarded for “B Delay” for this patent. Patentees respectfully submit that the PTO’s calculation of this “B Delay” is incorrect.

Section 154(b)(1)(B)(i) of Title 35 excludes from the calculation of “B Delay” “any time consumed by continued examination of the application.” In the present matter, a Request for Continued Examination was filed on July 26, 2010. The USPTO erred in the calculation of patent term adjustment by subtracting, from “B Delay,” a period of time that was not “consumed by continued examination of the application.” The USPTO mailed a Notice of Allowance on December 28, 2010, thereby closing examination of the application on that date. Thus, no continued examination took place during the 127 day period from December 28, 2010 (the mailing date of the Notice of Allowance) until May 3, 2011 (the date the patent was issued). Accordingly, 127 days of “B Delay” should have been included in addition to the 553 days accorded by the USPTO, for a total “B Delay” of 680 days. Patentees respectfully submit that the USPTO’s calculation of “B Delay” is incorrect and that the correct USPTO Delay for issuance beyond three years from filing is 680 days.

Overlap of “A Delay” and “B Delay”

As detailed above, 928 days of “A Delay” accumulated during the following period:

March 19, 2007, to October 1, 2009.

As detailed above, 680 days of “B Delay” accumulated during the following periods:

January 19, 2009, to July 26, 2010; and

December 28, 2010, to May 3, 2011.

As such, the periods of “A Delay” and “B Delay” overlap (i.e., occur on the same calendar day) for a total of 256 days, from January 19, 2009, to October 1, 2009.

Terminal Disclaimer

This patent is not subject to a Terminal Disclaimer.

Applicant : Robert Henri-Marcel Stouffs et al.
Patent No. : 7,935,190
Issued : May 3, 2011
Serial No. : 10/564,652
Filed : January 13, 2006
Page : 4 of 4

Attorney's Docket No.: 19790-0005US1 / CER03-0006

Conclusion

In consideration of the events described above, Patentees believe the PTA calculation of 1,179 days is incorrect. As such, Patentees respectfully request reconsideration of the PTA in the following manner:

- 1) Total USPTO Delay should be calculated as 1,352 days (i.e., the sum of 928 days of "A Delay" and 680 days of "B Delay" minus 256 days that overlap between the two);
- 2) Total Applicant Delay should be calculated as 46 days; and
- 3) Thus, total PTA should be calculated as 1,306 days.

The \$200 fee required under 37 C.F.R. § 1.18(e) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other credits or charges to Deposit Account No. 06-1050, referencing Attorney Docket No. 19790-0005US1.

Respectfully submitted,

/July 1, 2011/

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Date: _____

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